

IFW

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of: Hiroshi OGURA et al

Art Unit: 3729

Application No.: 10/713,351

Confirmation No.: 3168

Examiner: R. Chang

Filed: November 17, 2003

Washington, D.C.

For: METHOD OF MACHINING GLASS SUBSTRATE...

Atty.'s Docket: OGURA=1A

Date: June 21, 2004

MONDAY

Customer Window, Mail Stop  
THE COMMISSIONER OF PATENTS AND TRADEMARKS  
Arlington, VA 22202

Sir:

Transmitted herewith is a [XX] REPLY TO RESTRICTION REQUIREMENT in the above-identified application.

[ ] Small entity status of this application under 37 CFR 1.9 and 1.27 has been established by a verified statement previously submitted

[ ] A verified statement to establish small entity status under 37 CFR 1.9 and 1.27 is enclosed.

[XX] No additional fee is required.

The fee has been calculated as shown below:

(Col. 1)		(Col. 2)		(Col. 3)	SMALL ENTITY		OR	OTHER THAN SMALL ENTITY	
	CLAIMS REMAINING AFTER AMENDMENT		HIGHEST NO. PREVIOUSLY PAID FOR	PRESENT EXTRA EQUALS	RATE	ADDITIONAL FEE		RATE	ADDITIONAL FEE
TOTAL	*	MINUS	** 20	0	x 9	\$		x 18	\$
INDEP.	*	MINUS	*** 3	0	x 43	\$		x 86	\$
FIRST PRESENTATION OF MULTIPLE DEP. CLAIM					+ 145	\$		+ 290	\$
					ADDITIONAL FEE TOTAL	\$		TOTAL	\$

\* If the entry in Col. 1 is less than the entry in Col. 2, write "0" in Col. 3.

\*\* If the "Highest Number Previously Paid for" IN THIS SPACE is less than 20, write "20" in this space.

\*\*\* If the "Highest Number Previously Paid for" IN THIS SPACE is less than 3, write "3" in this space.

The "Highest Number Previously Paid For" (total or independent) is the highest number found from the equivalent box in Col. 1 of a prior amendment of the number of claims originally filed.

[XX] Conditional Petition for Extension of Time

If any extension of time for a response is required, applicant requests that this be considered a petition therefor.

[ ] It is hereby petitioned for an extension of time in accordance with 37 CFR 1.136(a). The appropriate fee required by 37 CFR 1.17 is calculated as shown below:

Small Entity

Response Filed Within

- [ ] First - \$ 55.00
- [ ] Second - \$ 210.00
- [ ] Third - \$ 475.00
- [ ] Fourth - \$ 740.00

Month After Time Period Set

Other Than Small Entity

Response Filed Within

- [ ] First - \$ 110.00
- [ ] Second - \$ 420.00
- [ ] Third - \$ 950.00
- [ ] Fourth - \$ 1,480.00

Month After Time Period Set

[ ] Less fees (\$ ) already paid for \_\_\_ month(s) extension of time on \_\_\_\_\_.

[ ] Please charge my Deposit Account No. 02-4035 in the amount of \$\_\_\_\_\_.

[ ] Credit Card Payment Form, PTO-2038, is attached, authorizing payment in the amount of \$\_\_\_\_\_.

[ ] A check in the amount of \$\_\_\_\_\_ is attached (check no. ).

[XX] The Commissioner is hereby authorized and requested to charge any additional fees which may be required in connection with this application or credit any overpayment to Deposit Account No. 02-4035. This authorization and request is not limited to payment of all fees associated with this communication, including any Extension of Time fee, not covered by check or specific authorization, but is also intended to include all fees for the presentation of extra claims under 37 CFR §1.16 and all patent processing fees under 37 CFR §1.17 throughout the prosecution of the case. This blanket authorization does not include patent issue fees under 37 CFR §1.18.

BROWDY AND NEIMARK

Attorneys for Applicant(s)

By:   
Sheridan Neimark  
Registration No. 20,520

Facsimile: (202) 737-3528  
Telephone: (202) 628-5197



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

ATTY.'S DOCKET: OGURA=1A

In re Application of:	)	Art Unit: 3729
	)	
Hiroshi OGURA et al	)	Examiner: R. Chang
	)	
Appln. No.: 10/713,351	)	Washington, D.C.
	)	
Date Filed: November 17, 2003	)	Confirmation No. 3168
	)	
For: METHOD OF MACHINING GLASS...)		June 21, 2004

REPLY TO RESTRICTION REQUIREMENT

Honorable Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

Applicants are in receipt of an Office Action mailed May 21, 2004, entirely in the nature of a restriction requirement.

Applicants have claimed priority from their corresponding application filed in Japan on June 12, 2000, and applicants filed a certified copy of the priority document in parent application 09/878,265. Accordingly, applicants respectfully request the PTO to acknowledge receipt of applicants' papers filed under \$119.

The PTO has required restriction between what it deems to be two (2) patentably distinct inventions as outlined

at the top of page numbered page 2 of the Official Action. As applicants must make an election, even though the requirement is traversed, applicants hereby respectfully and provisionally elect Group I presently claims 1 and 2, with traverse and without prejudice.

The Office Action states that restriction is proper because the method of Group I can be used for a materially different purpose than what is stated in Group II, namely it "can be used for creating decoration...." However, Groups I and II differ from one another on the basis of subcombination and combination. Group I, claims 1 and 2, recite an operation which is specifically called for in the Group II claims, namely "machining a glass substrate by using a CO<sub>2</sub> laser".

The present situation thus falls under MPEP 806.05(c)(ii), "Subcombination Essential To Combination". Under these circumstances, there should be no restriction.

Applicants respectfully request withdrawal of the restriction requirement and examination of all the claims on the merits.


Applicants do not understand paragraph 4 under the heading "Conclusion" commencing at the bottom of page 2 of the Office Action. Applicants have not received any action on the merits, and therefore do not see that there are any issues raised by the PTO which would suggest that any confusion

exists or that the examiner does not understand applicant's claims.

Applicants believe that all issues have been addressed above, and applicants accordingly respectfully await the results of an examination on the merits, desirably of all of applicants' claims.

Respectfully submitted,

BROWDY AND NEIMARK, P.L.L.C.  
Attorneys for Applicant(s)

By   
Sheridan Neimark  
Registration No. 20,520

SN:jaa  
Telephone No.: (202) 628-5197  
Facsimile No.: (202) 737-3528  
G:\BN\K\Kanf\OguralA\pto\Restrict reply Je04.doc